

Application No. 09/391,462

IN THE CLAIMS:

Please substitute amended claim 2 for pending claim 2 as follows:

2. (Amended) The system of claim 1, wherein the N-space data set is a graphical data set.

Remarks

Applicants thank the Examiner for his careful consideration of the application. Claim 2 is the only claim amended and as amended has the same or broader scope than it did originally.

Claim Rejections

Claim 2 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully request that the objection be withdrawn as Applicant has amended claim 2 to incorporate the alteration suggested by the Examiner.

Claim 9 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,340,931 (the '931 patent). This rejection is respectfully traversed.

Claim 9 recites a method for N-space navigation of digital data sets, including first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a first default navigational action.

Claim 1 of the '931 patent recites a printing control method using multiple electronic tags presented to an electronic tag reader connected to a network printer, the method comprising the steps of providing a first input from a first electronic tag, the first electronic tag having a first identification number that is associated with a network accessible document.

Application No. 09/391,462

Applicants' claim 9 is both broader and narrower than claim 1 of the '931 patent. Claim 9 recites reading an electronic tag having a digitally readable identifier. Claim 1 of the '931 patent recites providing a first input from an electronic tag having a first identification number. Claim 1 of the '931 patent does not require that the number be digitally readable, but does require that it be a number. Applicants do not require their identifier to be a number, but they do require it to be digitally readable. Therefore, Applicants submit that the Examiner has failed to make a prima facie case that claim 9 is obvious over claim 1 of the '931 patent.

Claims 1, 2, and 4-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al, U.S. Patent No. 6,342,830 (the '830 patent) in view of Pulley et al., U.S. Patent No. 6,222,557 (the '557 patent). These rejections are respectfully traversed.

Claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01. This suggestion must be found in the prior art, and cannot be based upon Applicants' disclosure. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, citing *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

Recently, the Court of Appeals for the Federal Circuit (CAFC) addressed this issue in *in re Lee* 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed Cir. 2002).

In *Lee*, the Examiner rejected the claims on the ground of obviousness, citing the combination of two references: United States Patent No. 4,626,892 to Nortrup, and the Thunderchopper Helicopter Operations Handbook for a video game. The Nortrup reference described a television set having a menu display by which the user can adjust various picture

Application No. 09/391,462

and audio functions. However, the Nortrup display did not include a demonstration of how to adjust the functions. The Thunderchopper Handbook described the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game. However, the Thunderchopper Handbook made no mention of the adjustment of picture or audio functions. The Examiner held that it would have been obvious to a person of ordinary skill to combine the teachings of these references to produce the Lee system. Lee appealed to the Board of Patent Appeals and Interferences (Board), arguing that the Thunderchopper Handbook simply explained how to play the Thunderchopper game, and that the prior art provided no teaching or motivation or suggestion to combine this reference with Nortrup, or that such combination would produce the Lee invention. The Board held that it was not necessary to present a source of a teaching, suggestion, or motivation to combine these references or their teachings. The Board stated, "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

The CAFC reversed the Board stating "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. . . . With respect to Lee's application, neither the Examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described." Lee 277 F.3d 1343.

While Applicants do not acknowledge disclosure of the elements of the claimed invention by the references, Applicants submit that the Examiner has not identified any suggestion in any of the references to combine the various features allegedly taught by their respective references to achieve the invention claimed in this patent application.

Claim 1 recites a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader

Application No. 09/391,462

configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

As in Lee, the Examiner has failed to establish that the references suggest the desirability of the invention disclosed in claim 1. The Examiner has stated that it would be obvious to combine the disclosures of the '830 and '557 patents to achieve the invention recited in claim 1. However, the Examiner has pointed to nothing in either the '830 patent, the '557 patent or the prior art in general that suggests that an electronic tag, an electronic tag reader, and a computing system as disclosed in the '830 patent should be combined with the navigation system and method of viewing a data landscape in an information visualization system disclosed in the '557 patent to achieve Applicants' claimed invention.

As the Examiner has failed to point to any motivation in the prior art to combine the references, the rejection should be withdrawn and claim 1 allowed. "The mere fact that references can be combined is not sufficient to establish prima facie obviousness." MPEP 2143.01.

The Examiner may also be of the position that the invention claimed in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness is determined under 35 U.S.C. §103. In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); In re Yates, 211 U.S.P.Q. 1149 (CCPA 1981); In re Goodwin, 576 F.2d 375, 198 U.S.P.Q. 1 (CCPA 1978).

For each of the above reasons, claims 2 and 4-8 should be allowed as claims 2 and 4-8 depend from claim 1.

Claim 9 recites a method for N-space navigation of digital data sets, including first reading a first electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a first default navigational action, and

Application No. 09/391,462

second reading within a determined duration of the first reading step a second electronic tag having a digitally readable identifier with an electronic tag reader, with the digitally readable identifier triggering a second default navigational action.

Claim 9 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. As explained in Applicants' arguments in response to the rejections of claim 1, the Examiner has failed to identify a suggestion in the prior art to combine the navigational process of the '557 patent with the tag and tag reader of the '830 patent.

Claims 1 and 3-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Beigel et al, U.S. Patent No. 6,249,212, in view of Card et al., U.S. Patent No. 5,847,709. These rejections are respectfully traversed.

Claim 1 recites a system for N-space navigation of digital data sets, which includes an electronic tag having a digitally readable identifier, an electronic tag reader configured to read the identifier of the electronic tag, a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

Again, claim 1 should be allowed as the Examiner has failed to establish a prima facie case of obviousness. To sustain a prima facie case of obviousness based upon a combination of references, the Examiner must point to some suggestion to combine the references. This suggestion must be found in the prior art, and cannot be based upon Applicants' disclosure. "The prior art must suggest the desirability of the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01. As the Examiner has failed to point to any motivation in the prior art to combine the references, the rejection should be withdrawn and claim 1 allowed. "The mere


Application No. 09/391,462

fact that references can be combined is not sufficient to establish prima facie obviousness."
MPEP 2143.01.

For the above reasons, claims 3-8 should be allowed as claims 3-8 depend from claim 1.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Respectfully submitted,



Joseph M. Young
Attorney for Applicant(s)
Registration No. 45,248
(585) 423-4554

JMY/pn
Xerox Corporation
Xerox Square 20A
Rochester, New York 14644

Application No. 09/391,462

VERSION WITH MARKINGS TO SHOW CHANGES MADE:

2. (Amended) The system of **claim 1**, wherein the N-space data set is a graphical data set. [[e.g. zoom-in, zoom-out, pan]]